REMARKS

Reconsideration of the application in view of the present amendment is respectfully requested.

By the present amendment, the specification has been amended to describe a feature shown in the drawing. Claim 2 has been canceled. Claims 1 and 3 have been amended to eliminate an alleged indefiniteness therein. Claim 1 has also been amended to more clearly define the present invention.

Based on the foregoing amendments and the following remarks the application is deemed to be in condition for allowance and action to that end is respectfully requested.

I. Amendment to the Specification

As noted above, the specification has been amended to bring the description in accord with the drawing which shows that the groove, which forms the flushing liquid conduit (6) is closed at the working tool side and is open at its opposite side to insure that the flushing liquid is introduced into the percussion working tool through an opening in the end surface thereof, as discussed in the specification (page 5, lines 1-2).

It is respectfully submitted that the foregoing amendment to the specification does not constitute new matter.

It is a long held view that the amendments to the specification are proper when they conform to the original drawings. Thus, the District Court of Northern California stated:

> An amendment does not constitute new matter where the amendment clarifies an inherent property of the invention as disclosed by the original application, or where it adds nothing to what a person skilled in the art would have learned from the original application, or where it includes matter clearly disclosed by drawings in the original application. (emphasis added).

Corometrics Medical Systems Inc. v. Berkely Bio-Engineering, Inc., 193 U.S.P.Q. 467, 476 (DC N. Calif. 1977).

The same view has been expressed by the Ninth Circuit Court of Appeals that stated:

> Resort may be made to the drawings to cure omissions in the description.

Omark Industries, Inc. v. Textron, Inc., 216 U.S.P.Q. 749, 753 (9th Cir. 1982).

The foregoing decisions are consistent with the holding in Vas-Gath, Inc. v. Mahurkar, 19 U.S.P.Q. 2d, 1117 (Fed. Cir. 1991) that "[D]rawings alone may

be sufficient to provide the "written description of the invention" required by § 112, first paragraph."

II. Rejection of Claims

The Examiner rejected Claim(s) 1, 3, 4 under 35 U.S.C. § 102(a) as being anticipated by Irving, U.S. Patent No. 3,215,443 (Irving). Claims 2 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Irving in view of, respectively, Nakamura, U.S. Patent No. 5,378,091 (Nakamura) and Taylor, U.S. Patent No. 2,827,019 (Taylor).

It is respectfully submitted that claims 1-5 are patentable over the cited references. Specifically, claim 1 recites that at least one flushing liquid conduit is formed as a groove in the inner surface closed at its working tool side. Thereby, flushing liquid is introduced into the percussion working tool through an opening formed in an end surface of the tool.

It is respectfully submitted that the foregoing novel feature of the present invention is not disclosed or suggested in the prior art, including all of the prior art of record in the subject application. Considering the prior art, Irving does not disclose forming a flushing liquid conduit as an inner groove. Nor does

Irving disclose or suggest introducing flushing liquid through an opening in an end surface of the tool.

In view of the above, it is respectfully submitted that Irving does not anticipate or make obvious the present invention, as defined by claim 1, and claim 1 is patentable over Irving.

It is further respectfully submitted that Nakamura does not make the present invention as defined by claim 1, obvious. Nakamura, while disclosing forming flushing liquid conduits as inner groove, does not disclose forming a flushing conduit as an inner groove closed at a working tool side thereof. In effect, forming such a groove would be contrary to the teachings of Nakamura. In Nakamura, the inner grooves (24) are necessarily open in the tool direction (their tool side) for flushing outside of the tool (please see Fig. 7a).

Thus, even assuming, *arguendo*, that Irving and Nakamura are combined, the combination would not disclose at least one flushing liquid conduit formed as a groove in the inner surface and closed at its working tool side.

Under MPEP § 2143 *prima facie* case ob obviousness requires that three basic criteria be met.

First, there must be some suggestion or motivation, either in the references or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitation.

It is respectfully submitted that at least the third element of *prima facie* obviousness has not established.

In view of the above, it is respectfully submitted that claim 1 is patentable over the combination of Irving and Nakamura.

Claims 3-5 depend on claim 1 and are allowable as being dependent on an allowable subject matter.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

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Dated: November 10, 2006
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This correspondence is being deposited with the United States Postal Service on November 10, 2006 in an envelope as "Express Mail Post Office to Addressee" Mailing Label Number **ER 059 677 321 US** addressed to the Honorable Commissioner for Patents, Alexandria, VA 22313-1450.

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